REMARKS/ARGUMENTS

The Office Action of August 1, 2005, has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

I. STATUS OF THE CLAIMS

Claims 1-20 are pending in the application.

Claims 1-10, 12-13, 15-17, and 20 have been amended. Support for any amendments of substance can be found in Applicants' Specification at the locations listed below.

Claims 1-10 are rejected under 35 U.S.C. § 101 because the Office Action states that the claimed subject matter is a software product for a computer system but not actively being used on a computer, and therefore not tangibly embodied.

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-11, and 13-20 of copending U.S. application # 09/821,917.

Claims 1-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Barrick et al., U.S. Patent Number 6,006,260, issued on December 21, 1999 (Barrick).

The cover sheet of the Office Action states that the Specification is objected to, but no objection to the Specification was found within the Office Action. Applicants assume the reference to the objection is merely a typographical error.

II. REJECTIONS UNDER 35 U.S.C. § 101

On page 2, in paragraphs 2-3, the Office Action states that claims 1-10 are rejected under 35 U.S.C. § 101. The Office Action states that the claimed subject matter is a software product for a computer system but not actively being used on a computer, and are therefore not tangibly embodied.

Applicants have amended claims 1-10 and now claim a computer program product comprising a computer usable medium having computer readable code embodied therein, which complies with the established wording in *In re Beauregard,* 53 F.3d 1583, 35 USPQ2d

1383 (Fed. Cir. 1995). The amendments are supported in Applicants' Specification, page 7, paragraph 14. No new matter has been added.

III. REJECTIONS UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING

On pages 2-3, in paragraphs 4-5, the Office Action states that claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-11, and 13-20 of copending U.S. Application # 09/821,917 ('917).

Applicants enclose herein a Terminal Disclaimer under 37 C.F.R. § 1.321(a) and the appropriate fee.

IV. REJECTIONS UNDER 35 U.S.C. § 102(e)

On pages 3-5, in paragraphs 6-15, of the Office Action states that claims 1-20 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Barrick.

Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims. In summary, Barrick does not anticipate Applicants' invention at least because:

(a) Nowhere does Barrick disclose or suggest Applicants' claimed test instructions to save the transaction for subsequent automated testing of the Internet server system. Barrick states in many places that timing information and user information are saved, but nowhere does Barrick save a transaction. Barrick states that individual web pages that may be invoked by the browser agent may be provided to the user, but nowhere does Barrick test instructions that save those web pages as a transaction (claims 1 and 11).

(b) Nowhere does Barrick disclose or suggest a storage medium configured to store the test instructions. In Barrick, test results and cookies can be stored. Both cookies and test results contain data, the former containing user information, the latter containing timing information of web page download. Neither test results nor cookies are test instructions as claimed by Applicants to direct a processor to interact with a web browser and server system to record web browser activity (claims 1 and 11).

Applicants assert that Barrick cannot anticipate Applicants' claims 1 and 11 (and claims 2-10 and 12-20 which, respectively, depend therefrom) for at least the above stated reasons and for reasons pointed out below.

On pages 3 and 5, in paragraphs 8 and 15, with respect to claims 1 and 11, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate the transaction (col. 2, lines 18-35; col. 4, line 60 – col. 5, line 6).

In the first cited passage (col. 2, lines 18-35), Barrick states that a browser agent is sent to a user machine in response to a user request to access a web page, the browser agent initiates a get message for the web page and records the time the get message is sent, the browser agent then records the time when the web page is loaded, the browser agent computes the time interval, and the browser agent provides a parameter indicative of the time interval in a modified get message. In other words, the browser agent tracks a loading time for each web page.

In the second cited passage (col. 4, line 60 – col. 5, line 6), Barrick states that a relay server transfers the download timing information and information about the user machine where it resides to a database server.

In the cited passages, Barrick does not disclose Applicants' claimed test instructions to record web browser activity to generate a transaction. Barrick states that loading time for a web page is recorded and transferred, along with information about the user machine, to a database server. Web browser activity, on the contrary, includes, for example, user

keystrokes such as user data entry into web pages. Nowhere does Barrick disclose or suggest recording web browser activity to generate a transaction.

On pages 3 and 5, in paragraphs 8 and 15, with respect to claims 1 and 11, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to edit the transaction (col. 2, lines 18-53; col. 8, line 27 – col. 9, line 45).

In the first cited passage (col. 2, lines 18-53), Barrick states that a browser agent is sent to a user machine in response to a user request to access a web page, the browser agent initiates a get message for the web page and records the time the get message is sent, the browser agent then records the time when the web page is loaded, the browser agent computes the time interval, and the browser agent provides a parameter indicative of the time interval in a modified get message. Barrick further states that a web server is configured to send a browser agent to a user in response to a user request, a relay server is configured to received from the user a modified get request that contains the performance parameter. In other words, the browser agent tracks a loading time for each web page and provides a parameter indicative of the loading time in a modified get request.

In the second cited passage, Barrick states that the browser agent can record the time the get request was sent and monitor the receiving of the page to determine the download time in a way that is transparent to the user, with no action required by the user save requesting a desired page. Barrick further states that a visible agent frame contains links to test pages that may be downloaded, that a display frame that is initially blank eventually contains the test page that is downloaded, that test pages are not downloaded automatically but are selected by the user from the links in the visible agent frame. Barrick even further states that the modified get request header contains download timing information and page station identifying information destined for the relay server, and an example get request header is provided. Barrick states that the data sent to the relay server as part of the cookie file contains information that identifies the user and the user's internet service provider so that the user does not have to input user information. In other words, Barrick relieves the

user of having to explicitly request that web page download timing be done, and relieves the user of having to enter user-specific information.

In the cited passages, however, Barrick does not disclose or suggest Applicants' claimed test instructions to edit the transaction. Editing a transaction could include, for example, changing the order of the web pages invoked, or changing the user data provided in the web page. First, Barrick does not disclose generating a transaction, and thus there is no transaction to edit. Next, Barrick does not disclose any sort of editing either performed by a user or automatically. Barrick simply times the difference between when a web page was requested and when the web page arrives without the user's requesting such timing. Barrick also creates a get request that contains the timing information in pre-defined header fields, but again, there is no editing taking place. Thus Barrick does not anticipate Applicants' claims 1 and 11.

On pages 4 and 5, with respect to claims 1, 6, 11, and 16,

a) The Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to perform an automated test of the Internet server system using the transaction and display test results to the user from the automated test

b) The Office Action states that Barrick further discloses the test instructions are further configured to direct the processor to record the browser activity as a series of steps and to edit the transaction to specify test measurements for each step (col. 2, lines 36-53; col. 7, line 52 – col. 8, line 26).

In the first cited passage (col. 2, lines 36-53), Barrick states that the browser agent logs a time associated with a get message, initiates the get message, records the time when the web page is loaded, computes the time interval, and provides a parameter indicative of the time interval in a modified get message. Barrick further states that a web server is configured to send a browser agent to a user in response to a user request, a relay server is configured to received from the user a modified get request that contains the performance

parameter. In other words, the browser agent tracks a loading time for each web page and provides a parameter indicative of the loading time in a modified get request.

In the second cited passage (col. 7, line 52 – col. 8, line 26), Barrick states that the browser agent records the time of sending the get request, the web server sends the requested web page, the browser agent calculates the time interval, the browser agent calculates other performance parameters in addition to or in place of the download interval, for example, the time required for the server to send the first byte or to end transmission. Barrick further states that the measurement and reporting functions are placed in a for loop so that the web browser can repeatedly access a web page, and can make repeated measurements and send multiple reports to the relay server. Barrick still further states that the browser agent can make a qualitative assessment of the performance and display it to the user. Barrick yet still further states that the user can first select an HTML page that contains the browser agent in a visible agent frame, and can make a page selection from this frame; the browser agent is then sent in response as part of a hidden agent frame that is included in an initial HTML page, and the JavaScript that implements the browser agent automatically sends a get request. In other words, the user initiates the browser agent through an HTML page, and the browser agent computes the time between when the get request is sent and when the web page associated with the get request is received.

Barrick does not disclose Applicants' claimed performing an automated test of the Internet server system using the transaction, or recording browser activity as a series of steps and editing the transaction to specify test measurements for each step and, as discussed previously, Barrick does not disclose a transaction.

Next, Barrick does not disclose recording browser activity as a series of steps, or recording browser activity at all. Recording browser activity as a series of steps involves recording the web pages that the user requests, the data entered into those web pages, and response to the requests, etc. Barrick simply sends out specific defined web pages and computes a download interval. In Barrick, no browser activity is recorded whatsoever, in steps or otherwise.

Finally, Barrick does not disclose editing the transaction to specify test measurements. Editing a transaction to specify test measurements can include, for example, changing the data entry into the web pages that are part of a transaction in order to, for

example, elicit a different response from the receiver. As stated previously, Barrick does not disclose any form of editing. Thus, Barrick does not anticipate Applicants' claims 1, 6, 11, and 16.

On pages 3 and 5, in paragraphs 8 and 15, with respect to claims 1 and 11, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to save the transaction for subsequent automated testing of the Internet server system; and a storage medium configured to store the test instructions (col. 2, lines 36-53; col. 9, lines 28-45).

The first cited passage (col. 2, lines 36-53) has been summarized and will not be repeated here except to point out that, in the cited passage, Barrick states that the browser agent tracks a loading time for each web page and provides a parameter indicative of the loading time in a modified get request.

In the second cited passage (col. 9, lines 28-45), Barrick states that data sent to the relay server as part of the cookie file is part of the get message header or page station identifier, the cookie file identifies the user and the user's internet service provider, and the user doesn't have to input information that is not known to the browser agent but that is in the cookie. In other words, Barrick relieves the user of redundant data entry by making use of fields in the get message header and by making use of cookies.

Barrick does not disclose Applicants' claimed saving the transaction because Barrick does not disclose or suggest a transaction at all. In Barrick, repetitious testing can be conducted by a measurement loop in which the same web page is sent out over and over, but nowhere does Barrick disclose recording web browser activity to save a transaction. Further, Barrick does not disclose Applicants' claimed storage medium configured to store the test instructions. In Barrick, test results can be stored on a central database (Barrick col. 2, line 8), and in Barrick, user information can be stored in a cookie, but nowhere does Barrick disclose or suggest storing test instructions, Applicants' claimed instructions that direct a processor to interact with a web browser and Internet server system to record web browser activity. Neither test results nor cookies direct a processor to interact with a web browser and

server system to record web browser activity. Both test instructions and cookies are simply data. Therefore Barrick does not anticipate Applicants' invention as claimed in claims 1 and 11.

On pages 4 and 5, with respect to claims 3, 4, 13, and 14, the Office Action states that Barrick discloses the test instructions are further configured to direct the processor to record the web browser activity to generate test measurements, wherein one of the test measurements is a sequence of web pages (col. 2, lines 18-35; col. 4, lines 60 – col. 5, line 6).

The first cited passage (col. 2, lines 18-35) has been summarized with respect to claims 1 and 11 and will not be repeated here except to point out that the cited passage states that the browser agent tracks a loading time for each web page.

In the second cited passage (col. 4, lines 60 – col. 5, line 6), Barrick states that the browser agent sends download timing information and user machine information obtained during the registration process to a relay server in the form of a get request that has a predefined format, and that the relay server transfers the data to a database server which can be located in various places.

Barrick does not, however, disclose Applicants' claimed recording of web browser activity to generate test measurements, which can include a sequence of web pages. In Barrick, the timing of individual and autonomous web pages is tracked and provided along with identifying information, but Barrick does not disclose recording web browser activity, nor generating a sequence of web pages. In Barrick, web pages are requested, but not generated. In the system of Barrick, a browser agent receives and relays a request for a web page, but does not generate a web page. Thus, Applicants assert that Barrick does not anticipate Applicants' claims 3 and 4.

On pages 4 and 5, with respect to claims 5, 7-9, 15, and 17-19, the Office Action states that Barrick discloses the test instructions are further configured to direct the processor (a) to add test measurements to the transaction including transaction time and transaction data transfer rate, and (b) that one of the test measurements for each step is elapsed time, one of the test measurements for each step is a required string in an Internet server system response and one of the test measurements for each step is a prohibited string in an Internet server system response (col. 7, lines 9-67).

In the cited passage (col. 7, lines 9-67), Barrick states that the process flow for Barrick's system includes the steps of the user's selecting an HTML page that contains the browser agent, the system's retrieving the requested page with the browser agent (or some variant of those two steps resulting in the browser agent's intercepting web page requests). Barrick further states that a browser agent may be explicitly chosen by the user, the browser agent may provide a list of pages that can be downloaded that are supported by the browser agent or the browser agent may automatically select a page. Barrick still further states that the browser agent contains JavaScript functions and an HTML page that contains logical definitions of a single web page, that a hyperlink within the HTML page containing the browser agent is selected to download the test page or the test page may be downloaded automatically by the browser agent. Barrick yet still further states that the browser agent records the time of sending the get request, the web server sends back the requested web page, the browser agent calculates the download interval (and possibly the time required for the server to send the first byte to or end transmission), encodes it in a get request header, and sends the get request to a relay server. Barrick finally states that measurement and reporting functions can be placed in a for loop so that the web browser repeatedly accesses a web page. In other words, Barrick's browser agent requests a single autonomous web page, perhaps repeatedly, and measures the download interval for that single web page.

Barrick does not disclose or suggest Applicants' claimed adding test measurements to a transaction including transaction time and transaction data transfer rate. Barrick does not disclose a transaction. Even if the user's or browser agent's selection of a single web page from a list of possible web pages could be considered a transaction, a premise with which Applicants do not agree, nowhere does Barrick disclose adding test measurements to a transaction. Barrick would have to modify a transaction in some way to include the test measurements, which Barrick does not do. In Barrick, the download interval time is included in a created message header which is sent to a relay server. Thus, if any modification is occurring, it is occurring within a particular message, not to a transaction. For these reasons, Barrick does not anticipate Applicants' claim 5.

Barrick does not disclose Applicants' claimed test measurements for each step including elapsed time, a required string in a server system response, and a prohibited string in a server system response. In Barrick, download time for a web page is the only metric disclosed. There is no concept in Barrick such as transaction steps between which an elapsed

time can be computed. In Barrick, there is no mention whatsoever of the contents of the web page, including required and prohibited strings. Barrick states the contents of the browser agent HTML page, but those contents contain simply a pointer to the web page that is actually retrieved. There is no mention of the form or required/prohibited return content of the web page that is retrieved, and thus Barrick cannot anticipate Applicants' claims 7-9.

On page 5, with respect to claims 10 and 20, the Office Action states that Barrick discloses the test instructions are further configured to direct the processor to record pauses for the steps and edit the transaction to redefine the pauses (col. 8, line 27 – col. 9, line 45).

In the cited passage (col. 8, line 27 – col. 9, line 45), Barrick states that the browser agent can record the time the request was sent and monitor the receiving of the page to determine the download time without user intervention, and can send the download time to a relay server. Barrick states that the purpose of the tool is to provide download timing information to a web page provider. Barrick further states the contents of a frame set including a visible agent frame with links to test pages that may be downloaded, a display frame containing the test page that is downloaded, an agent frame containing a set of links to test pages that may be downloaded by the browser agent and displayed in display frame. Barrick still further states the fields, known as page station identifier, in a get request header that can contain download timing information that is provided to a relay server, and the fields that contain latitude and longitude information, an agent type ID field, a service provider field, a customer ID field, and a page ID field. Barrick states that data sent to the relay server as part of the cookie file is part of the get message header or page station identifier, the cookie file identifies the user and the user's internet service provider, and the user doesn't have to input information that is not known to the browser agent but that is in the cookie. In other words, Barrick relieves the user of redundant data entry by making use of fields in the get message header and by making use of cookies.

Barrick does not disclose Applicants' claimed recording pauses for the steps of a transaction, nor editing the transaction to redefine the pauses. The cited passage contains no reference whatsoever to pauses between steps of a transaction. Any mention of timing in Barrick is with respect to the download interval, not to pauses between web page accesses, or anywhere else. Therefore, Barrick cannot anticipate Applicants' claims 10 and 20.

Since Barrick does not anticipate each and every element of Applicants' independent claims 1 and 11, either expressly or inherently, Applicants' independent claims 1 and 11, as well as dependent claims 2-10 and 12-20 that depend, either directly or indirectly, therefrom and that further define the invention, a rejection under 35 U.S.C. § 102 is inappropriate. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Barrick to meet Applicants' patentable limitations.

Applicants respectfully assert that independent claims 1 and 11, as well as claims 2-10 and 12-20 that depend, either directly or indirectly, therefrom and that further define the invention are now in condition for allowance. Applicants respectfully request the Examiner to withdraw rejections under 35 U.S.C. § 102(e) for the reasons set forth above and find claims 1-20 to be allowable.

V. CONCLUSION

Applicants assert that claims 1-20 are currently in condition for allowance because:

(1) The 35 U.S.C. § 101 rejection of claims 1-10 has been overcome herein;

(2) The enclosed Terminal Disclaimer under 37 C.F.R. § 1.321(a) has overcome the obviousness-type double patenting rejection of claims 1-20; and

(3) The absence from any cited reference against Applicants' claimed invention as set forth above renders Barrick insufficient to anticipate claims 1-20 under 35 U.S.C. § 102, or render claims 1-20 unpatentable under 35 U.S.C § 103.

Applicants respectfully assert that independent claims 1 and 11 are believed to be in condition for allowance and all dependent claims that depend upon allowable independent claims are therefore also believed to be in condition for allowance. In view thereof Applicants respectfully request the Examiner to find claims of this case allowable and to pass the application to issue.

Applicants will be providing, under separate letter, a Supplemental Information Disclosure Statement for Examiner's consideration.

The Commissioner for Patents is authorized to charge the amount of $130 (large entity) to cover the cost of the enclosed Terminal Disclaimer, or any further additional fees, or credit overpayment to Deposit Account No. 50-1078.

The following information is presented in the event that a call may be deemed desirable by the Examiner:

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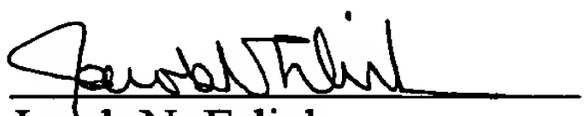
Respectfully submitted,
Ellen M. Nelson et al., Applicants

Date: November 1, 2005

By: 
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